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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,440	11/04/2003	Vilho Nissinen	3397-94DV3	5664

7590

05/06/2005

COHEN, PONTANI, LIEBERMAN & PAVANE  
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New York, NY 10176

EXAMINER
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RESAN, STEVAN A

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/700,440

Applicant(s)

NISSINEN ET AL.

Examiner

Stevan A. Resan

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3-07-2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56-58 and 60-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-58 and 60-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7 March 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 56-58, and 60-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Mochizuki et al US 6238784.
3. Claims 56-58 and 60-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Hart et al US 5093309.
4. Claims 56-58 and 60-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Okado et al US 5637432.
5. Applicant's arguments filed 7 March 2005 have been fully considered but they are not persuasive.

Applicants argue that in the Mochizuki and Hart references the particles have to be attached to the polymer layer either by heating or using a softened binder or binder layer that attaches the particles to the layer, that such a polymeric layer cannot be used in the manufacture of printing papers and that it was doubtful that inorganic particles could be attached on a polymer layer without a specific binder.

In response the examiner points out that the present claims are not limited to a "printing paper" or any other paper (Claim 62 encompasses "a non woven product" containing "other material" suitable for manufacturing "a non woven product".) nor do they exclude binders. (See specification page 3 lines 30-33). Furthermore there is no evidence of record to support applicants position that the particles of the references cannot be attached on a polymer layer (which includes a non woven polymer fiber layer) without a specific binder.

Note that the manner in which an article is made (even by a patented process) does not convey patentability to the product unless it can be demonstrated that the product itself is patentably distinct nor does producing a product on an "industrial scale" impart patentability.

With respect to adherence by van der Waals forces, note that "at least by van der Waals forces" is open claim language that does not exclude other forces such as adhesive bonding as with a binder. Particles capable of bonding by van der Waals forces are presumed to bond unless it can be demonstrated that other forces prevent this bonding.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (571) 272-1513. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Carol Chaney, can be reached on (571) 272-1284

Art Unit: 1773

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.



**STEVAN A. RESAN**  
**PRIMARY EXAMINER**